

REMARKS/ARGUMENTS

35 USC § 103(a)

Reconsideration and allowance are requested of Claims 5, 7, 10-12, and 14 which the Examiner has rejected under 35 USC § 103(a) as being unpatentable over Rogers et. al. Applicant respectfully requests allowance of New Claims 15-19. A *prima facie* case of obviousness requires (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations. In re Sang-Su Lee, 277 F.3d 1338, 61 USPQ 2d 1430 (Fed. Cir. 2002) (and cases cited therein). Applicant respectfully submits that a *prima facie* case has not been established because the prior art references do not teach or suggest all the claim limitations.

Claims 5 and 11

The Examiner has rejected independent Claims 5 and 11 because, according to the Examiner, the Applicant has merely eliminated Rogers' "Pre-Break" step, and "elimination of a known step/element and its function does not result in patentable subject matter." Applicant respectfully submits that the Examiner's statement is erroneous because Applicant's claimed invention does not merely eliminate the "Pre-Break" step in Rogers. Rather, Applicant's "breaking" step in Claim 5 and "degerminating" step in Claim 11 are comparable to Rogers "Pre-Break" step because Rogers' "Pre-Break" step is a breaking step where the oats are broken into several

pieces.¹ Degermination is the process whereby the kernel of corn is fractured via a mechanical process thereby freeing and removing the germ from the remaining parts of the kernel.² Therefore, Applicant's claimed invention actually adds a sifting step after Rogers' "Pre-Break" step, rather than eliminating the "Pre-Break" step.

The addition of this sifting step provides significant advantages over the cited prior art. After Rogers' "Pre Break" step, there is some grain that could be sifted out as finished product; however, instead of removing finished product after the "Pre Break" step, Rogers discloses directing the stream on to an additional breaking step. By contrast, in Applicant's claimed invention, finished product is extracted as soon as possible (after the first separation step) so that efficiency is increased because further sifting of an already isolated stream is not required. This results in a dramatic decrease in handling of product and a reduction or elimination of flow across subsequent process steps.

New Claims 15-19

Claims 15-19 claim a grain milling process as shown in Applicant's FIGS. 5 and 6, and described in Applicant's specification. The process claimed in Applicant's Claims 15-19 is not taught or suggested by the cited prior art. The milling process as claimed in these claims is advantageous over the cited prior art because it has several different grain streams moving simultaneously through the process. Sifters separate the grain into these separate streams by size so that different streams are directed to different

¹ Rogers' "pre-break" step is the initial cracking of the oat groats. (Rogers col. 3, lines 65-66.)

² See Applicant's Specification Page 1, Lines 21-23.

break rollers which may have different settings appropriate for the particular size of grain in that stream. Applicant's claimed process allows the appropriately sized grain to be directed to the grain stream that will most efficiently process that size of grain. For example, after degermination and an initial separation step, it may be more efficient for a particular size of grain to skip the first and second break rollers and be diverted directly to the third break roller. In this case, Applicant's Claim 15 claims that "at least one of the remaining size classes from the first separation step [is diverted to] to a third break roller" This increases efficiency and grain throughput by allowing the proper sized grain to be immediately directed to the proper break roller.

Further, as discussed above with regard to Claims 5 and 11, in Claim 15 there is a separation step wherein finished product is removed from the mill stream after each breaking step. This is not taught or suggested by the cited prior art, and is advantageous over the cited prior art for the reasons stated above with regard to Claims 5 and 11.

Conclusion

Applicant respectfully submits that the Claims not discussed above are dependant on either Claims 5, 11, or 15, and are therefore patentable for the reasons asserted above.

It is respectfully submitted that this response places Applicant's application in condition for allowance, and therefore further and favorable action on this application is requested.

Respectfully submitted,
JOHN GRIEBAT

By: 

Ryan N. Carter
Attorney for Applicant

Ryan N. Carter
Shuttleworth & Ingersoll, PLC
115 3rd Street SE, Suite 500
P.O. Box 2107
Cedar Rapids, IA 52406
Phone: (319) 365-9461
Fax: (319) 365-8443
Email: rnc@shuttleworthlaw.com
Reg. No.: 51,533
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Ryan N. Carter, Registered Representative